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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,040	02/08/2002	Tonya M. McBride	01464-067001 / TPV/SEBC	3632
26161	7590	03/10/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 03/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,040

Applicant(s)

MCBRIDE ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-9-05, 10-21-05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

All remaining rejections follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26 and 28-39 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Kinoshita et al. (either US 2001/0053816 or US patent 6,653,401 corresponding to the published application).

Kinoshita et al disclose a composition in Example 12 of Table 2 in which "TPV-6" , which is a dynamically vulcanized blend of PP and TPE-3 (see paragraphs 105 and 106 for TPE-3 and paragraphs 150 and 151 of the published application where it is used to make TPV-6) is blended with "HTR", defined at paragraphs 132 and 133 of the published application as hydrogenated styrene butadiene copolymer (TUFTEC), the compatibilizer recited by patentees claims. Note the process for production of the composition of Example 12 at paragraph 162 of the published application which entails melt kneading the components.

Claims 26 and 28-39 are rejected under 35 U.S.C. 102(b) as anticipated by Petrakis et al. (US 5,824,400), newly cited by applicants.

Patentees disclose a composition containing a dynamically vulcanized mixture of polypropylene and EPDM "TE(EPDM-X-PP)" and SEBS block copolymer. Note column 4, lines 17-50 and including Examples I and II. The degree of crosslinking is preferably at least 85% at column 2, lines 46-51. It is noted that by "fully crosslinked" applicants intend that some small amount of rubber may be uncrosslinked as evidenced by solubles as set out at the paragraph bridging pages 2 and three of the instant specification and therefore the 85% of patentees would appear to encompass applicants definition.

Claims 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakis et al., cited above.

Applicants may argue that 85% crosslinking does not embrace "fully cross-linked" as required by the claims. However , the term "preferably more than 855) as disclosed by

patentees imply higher amounts of crosslinking are workable or desirable and thus imply that amounts certainly less than 5% (much less "about 5%") would be workable or desirable and thus to use such amounts would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate or superior results absent any showing of surprising or unexpected results.

Claims 26, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ouhadi et al. (US 2003/0083434).

Patentees disclose a composition containing vulcanized EPDM in polypropylene ("SP8211-55W237 as well as SP991 145W237) in combination with styrenic block copolymer (note Examples 1-16 on page 5).

Claims 30-39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ouhadi et al., cited above.

Applicants may argue that the EPDM of patentees disclosed in paragraphs 64 and 65 of the published application are not "fully cross-linked" as defined by applicants. However the fact that patentees desired a vulcanized EPDM implies that crosslinking was considered desirable by applicants and thus implying full crosslinking inherent in the tradenamed materials "SP8211-55W237 as well as SP991 145W237.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 30-39 are rejected under 35 U.S.C. 102 (a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1116747, newly cited by applicants (equivalent to US 6,723,776).

Patentees dynamically vulcanize a mixture of EPDM, PP and styrenic block copolymer. See examples 5-9 of both documents.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

The declaration filed on 11-29-05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kinoshita reference.

Applicants patent application was not available as of the date applicants Exhibit A was originally prepared and can't be used as evidence as to the identity of the various components, not do applicants appear to allege that the components of Exhibit A are the exact same components of the reference or provided evidence that they are obvious variations of such. In order for an declaration to be effective it must show possession of as much of the claimed subject mater as is disclosed by the reference. Actually the identity of some of the materials such as uniprene do not even appear to be disclosed by the application nor is it clear that the uniprene is fully cross linked as defined by

applicants. The Kinoshita (US 6653401) reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Applicant's arguments filed 11-29-05 have been fully considered but they are not persuasive. The defects in applicant's declaration have been set out above.

Applicants appear to request an interview in their response. If applicants still desire an interview after reviewing the above examiner they may contact the examiner to set up a time for one.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis  
J Mullis  
Art Unit 1711

JCM

3-3-06



**Jeffrey Mullis**  
**Primary Examiner**  
**Art Unit 1711**